

Serial Number: 09/640,856

Docket Number: 10990089-1

**REMARKS**

Upon entry of this Response, claims 1-6 and 13-20 remain pending in the present application. Claims 1, 4, 13, 15, and 17 have been amended, and claims 7-12 have been canceled. Applicant requests reconsideration of the pending claims in view of the following remarks.

With respect to item 3 of the Office Action, claims 1-9 and 13-16 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 4, 6, 8, 9, 11, 13, 15, 16, 18, 20, 22, 24, and 25 of co-pending application number 09/640,855. Applicant takes note of this provisional obviousness-type double patenting rejection and will take steps to file a terminal disclaimer if appropriate in view of amendments made to the pending claims to both the present application and co-pending application number 09/640,855.

Next, in item 5 of the Office Action, claims 1, 2, 4, and 13-15 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 5,467,434 issued to Hower, Jr. et al. (hereafter "Hower"). Anticipation under §102 "requires the disclosure in a single prior art reference of each element of the claim under construction. W.L. Gore & Associates, Inc. v. Garlock, Inc., 220 USPQ 303, 313 (Fed. Cir. 1983). For the reasons that follow, Applicant asserts that Hower fails to show or suggest each of the limitations of claims 1 and 13 as amended herein. Accordingly, Applicant respectfully requests that the rejection of claims 1 and 13 be withdrawn.

In particular, claim 1 as amended provides as follows:

1. (Currently Amended) A system in a queue server for controlling the printing of a document, comprising:
  - a processor coupled to a local interface;
  - a memory coupled to the local interface; and
  - print queue logic stored in the memory and executable by the processor, the print queue logic including:
    - logic to place a print job ticket received from a client over a network in a printing queue, the printing queue determined by information contained in the print job ticket;
    - logic to determine if a printer associated with the printing queue is available to print the document, wherein the document remains stored in the client; and
    - logic to transmit the print job ticket to a print server associated with the printer if the printer is available to print the document, wherein the print job ticket identifies the address of the client on a network.

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Applicant asserts that Hower fails to show or suggest placing a print job ticket in a printing queue based upon information contained in the print job ticket, and then determining if a printer associated with the printing queue is available for printing the document, where the document itself remains stored in the client that generated the print job. Also, Applicant asserts that Hower fails to show or suggest transmitting the print job ticket to a print server when it is determined that the printer associated with the printing queue is available for printing the document. Also, Hower fails to show or suggest the fact that the print job ticket identifies the address of the client on the network.

In this respect, the present invention reflects the fact that the print job remains at the client and the print job ticket is transmitted alone to the queue server to be placed in an appropriate printing queue. The print job ticket is then provided to a print server when printing is to be performed based upon the availability of the respective printer. The address of the client on the network is included in the print job ticket so that the queue server can determine where to obtain the actual document on the network that is to be printed. The printing of a document requires a single transmission of the document over the network, thereby reducing the amount of network bandwidth that is used during the printing process.

In view of the foregoing, Applicant requests that the rejection of claim 1 be withdrawn. In addition, Applicant notes that claim 13 has been amended in a manner similar in scope with claim 1 described above. Accordingly, Applicant requests that the rejection of claim 13 be withdrawn for the same reasons described above with respect to claim 1. In addition, claims 2 and 4, and 14-15 depend from claims 1 and 13, respectively. Applicant requests that the rejection of claims 2, 4, and 14-15 be withdrawn as depending from claims 1 and 13, respectively.

In addition, in item 10 of the Office Action, claim 6 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Hower. A prima facie case of obviousness is established only when the prior art teaches or suggests all of the elements of the claims. MPEP 2143.03, In re Rijckaert, 9 F.3d 1531, 28 U.S.P.Q2d 1955, 1956 (Fed. Cir. 1993). Applicant notes that claim 6 depends from claim 1 described above. In this respect, Applicant requests that the rejection of claim 6 be withdrawn as depending from claim 1 for the same reasons described with respect to claim 1 as amended above.

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Next, in item 12 of the Office Action, claim 7-11 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Hower in view of U.S. Patent 5,5178,316 issued to Hube, (hereafter "Hube"). Applicant notes that claim 7-12 have been canceled herein, thereby rendering this grounds of rejection with respect to claims 7-11 above moot.

In item 17 of the Office Action, claims 3, 5, and 16 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Hower in view of U.S. Patent 5,327,526 issued to Nomura (hereafter "Nomura"). Applicant notes that claim 3 and 5 depend from claim 1, and claim 16 depends from claim 13 amended herein. Accordingly, Applicant requests the rejection of claims 3, 5, and 16 be withdrawn for the same reasons described above with respect to claims 1 and 13.


In addition, claim 12 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Hower in view of Hube and further in view of Nomura. Applicant notes that claim 12 has been cancelled herein, thereby rendering this grounds of rejection moot with respect to such claim.

In addition, Applicant notes that claims 4, 15, and 17 have been amended so as to be consistent with the amendments to claims 1 and 13 from which such claims depend, respectively.

#### CONCLUSION

Applicant respectfully requests that all outstanding objections and rejections be withdrawn and that this application and all presently pending claims be allowed to issue. If the Examiner has any questions or comments regarding Applicant's Response, the Examiner is encouraged to telephone Applicant's undersigned counsel.

Respectfully submitted,

  
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